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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 09/868,930 | 10/16/2001 | Jacques Delarge | P66806US0 | 9910 |
| 136 | 7590 | 06/03/2004 | EXAMINER | |
| JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004 | | | COLEMAN, BRENDA LIBBY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1624 | |

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,930

Applicant(s)

DELARGE ET AL.

Examiner

Brenda Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-26, 29, 30, 34-37, 40 and 41 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 23, 25, 29 and 30 is/are allowed.
6) ☒ Claim(s) 34-36 and 40 is/are rejected.
7) ☒ Claim(s) 24, 26, 37 and 41 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 23-26, 29, 30, 34-37, 40 and 41 are pending in the application.

This action is in response to applicants' amendment filed March 9, 2004. Claims 23-26, 29, 30, 34-37, 40 and 41 have been amended and Claims 27, 28, 31-33 38, 39 and 42-44 have been canceled.

Response to Amendment

Applicant's amendments filed March 9, 2004 have been fully considered with the following effect:

1. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, first paragraph rejection of claims 23, 24, 29, 31-35, 40 and 42-44, labeled paragraph 1 in the last office action, which is hereby **withdrawn**.
2. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled 3j), 3r) and 3ag) in the last office action, which are hereby **withdrawn**.
3. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, first paragraph rejection of claims 23, 24, 28, 29, 31-35, 39, 40 and 42-44, labeled paragraph 6 in the last office action, which is hereby **withdrawn**.
4. With regards to the 35 U.S.C. § 112, first paragraph rejection of claims 23-25, 27-29, 34-36, 38-40 and 42-44, labeled paragraph 7 in the last office action, the applicants' arguments have been fully considered, however they were not found persuasive. The applicants' stated that the rejections have been overcome through the above cancellation

and amendments and that claim 23 and their corresponding dependent claims have been amended to delete "radio-labeled" and to define that R_1 and R_2 , which can be identical or different, represent each independently a saturated or unsaturated linear or branched alkyl group with 2 to 12 carbon atoms. However, with regards to claim 34 and their corresponding dependent claim "radio-labeled" has not been deleted.

Claims 34-36 and 40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for reasons of record and stated above.

5. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, first paragraph rejection of claims 30 and 41, labeled paragraph 8 in the last office action, which is hereby **withdrawn**.

6. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 9 in the last office action, which are hereby **withdrawn**.

7. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 102 anticipation rejection labeled paragraph 10 in the last office action, which is hereby **withdrawn**.

In view of the amendment dated March 9, 2004, the following new grounds of rejection and/or reinstated rejections apply:

Claim Objections

8. Claims 24, 26, 35 and 37 are objected to because of the following informalities:

- a) Claim 24 defines X as an iodine group, however iodine is an element.

It is believed that the applicants intended iodo.

- b) Claim 26 contains a typographical error, i.e. 2,3-dimehtylphenyl.

- c) Claim 35 defines X as an iodine group, however iodine is an element.

It is believed that the applicants intended iodo.

- d) Claim 37 contains a typographical error, i.e. 2,3-dimehtylphenyl.

Appropriate correction is required.

9. Claims 35-37, 40 and 41 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable Subject Matter

10. Claims 23, 25, 29 and 30 are allowed. None of the prior art of record or a search in the pertinent art area teaches the compounds of the instant invention as claimed herein.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until

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after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman
Primary Examiner Art Unit 1624
May 28, 2004